

REMARKS

Claims 1-21 are pending in the application. New claim 21 has been added.

Claim Rejections - 35 U.S.C. § 112

Claims 3, 4, 6, 17, and 18 have been rejected under 35 U.S.C. § 112, second paragraph, because of some informalities.

The rejected claims have been amended to overcome this rejection.

The Examiner is respectfully requested to reconsider and withdraw this rejection.

Further, minor changes have been made to the pending claims to place them in better form for U.S. practice.

Claim Rejections - 35 U.S.C. § 103

(a) Claims 1-6, 9, 17, and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida (USP 6,205,316) in view of Mihalik (USP 3,918,702). This rejection is respectfully traversed.

In page 4 of the Office Action, the Examiner states that he feels “it would be obvious to one of ordinary skill in the art to modify Iida so as to remove the spring and merely use the weight of the lug to allow the tip to contact the roller, as taught by Mihalik, since removal of the spring provides a simpler device in that it has fewer parts.” Applicants respectfully disagree.

Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation. Second, there must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all the claimed

limitations. The Examiner has failed to establish at least the first criterion for the following reasons (MPEP § 2143).

1. Fact that References can be Combined or Modified is not Sufficient to Establish *Prima Facie* Obviousness

Iida discloses, in Figs. 1, 4, and 5, a paper-separating lug 36 pivotally supported by a shaft 81. The lug 36 has a tip 82 adapted to make contact with a surface of a hot roller 12, and a downstream roller 37b that makes contact with a recording paper 15.

As shown in Fig. 4, when the recording paper 15 does not make contact with the downstream roller 37b, the lug 36 is urged to rotate about the shaft 81 in a clockwise direction by a spring 18, such that the tip 82 makes contact with the hot roller 12. As shown in Fig. 5, when the downstream roller 37b makes contact with the recording paper 15, the force on the roller 37b rotates the lug 36 in a counter-clockwise direction against the force of the spring 18, such that the tip 82 moves away from the hot roller 12.

The Examiner simply states that it would be obvious to one of ordinary skill in the art to modify Iida so as to remove the spring and merely use the weight of the lug to allow the tip to contact the roller.

However, in order to remove the spring and use the weight of the lug to allow the tip to contact the roller, the weight of the paper-separating lug 36 to the right of the shaft 81 must be heavier than the weight to the left of the shaft 81, such that a clockwise moment is generated about the shaft 81. Iida simply relies on the spring 18 to urge the lug 36 to rotate in a clockwise direction, and does not disclose or suggest that the weight of the lug 36 to the right of the shaft 81 must be heavier than the weight to the left of the shaft 81.

Further, it would be much easier for one skilled in the art to provide a spring that urges the tip 82 towards the roller and not worry about the balance of the lug 36 about the shaft 81, rather than removing the spring and designing the lug 36 to have a suitable weight balance.

Therefore, Applicants respectfully submit that Iida does not suggest and does not motivate one of ordinary skill in the art to modify Iida so as to remove the spring.

2. The Proposed Modification Cannot Render the Prior Art Unsatisfactory for its Intended Purpose

The Examiner simply assumes that it would be obvious to one of ordinary skill in the art to modify Iida so as to remove the spring and merely use the weight of the lug to allow the tip to contact the roller, since the removal of the spring provides a simpler device in that it has fewer parts.

Applicants respectfully submit that mere removal of a part or parts to provide a simpler device does not establish *prima facie* case of obviousness.

There is not teaching in Iida that the lug 36 will rotate in a clockwise direction by its own weight without the spring 18. By removal of the spring 18, the lug 36 may simply not rotate or may rotate in a counter-clockwise direction by its own weight and render the apparatus unsatisfactory for its intended purpose.

In view of this, Applicants respectfully submit that this art grounds of rejection is improper.

Further, Mihalik merely discloses a stripping finger 4 having a stripping tip 6 that makes contact with a drum.

Therefore, even assuming that Iida and Mihalik can be combined, which Applicants do not admit, Iida in view of Mihalik fails to disclose or suggest “urging at least one of the paper-separating fingers to, under the force of its own weight, bring at least one or more of the finger bodies into abutting engagement with at least one or more photosensitive bodies,” as required in claim 1.

Moreover, both Iida and Mihalik fail to disclose or suggest “one or more support components pivotably supporting at least one or more of the paper-separating fingers so as to impart one or more restoring forces thereto urging at least one of the paper-separating fingers to, under the force of its own weight, bring at least one or more of the finger bodies into abutting engagement with at least one or more photosensitive bodies, so as to, when at least one of the guide member or members is touching at least one of the sheet or sheets of paper, cause at least one of the finger bodies to at least partially overcome one or more restoring forces produced by the weight of at least a portion of at least one of the paper-separating fingers and back off from at least one or more photosensitive bodies,” as recited in claim 1.

More specifically, as the Examiner acknowledges in the Office Action, Iida’s finger body (82) does not serve to separate sheets of paper. Iida’s finger body removes an unnecessary developer attached to a fusing roller (12) by coming into contact therewith. Thus, a person skilled in the art can easily understand that there is a critical difference between the separating force of the claimed invention for separating paper from the photosensitive body (the force is generated by urging the finger body back and forth under its own weight) and the separating force of Iida for removing a developer from a fusing roller (the force is generated by urging the finger body back and forth by means of a spring). Based on this technical background, Iida’s

finger body inevitably requires a spring. Although the Examiner appears to feel that it would be obvious to one of ordinary skill in the art to modify Iida so as to remove the spring from the paper separator, the Examiner's statement is impermissibly made in hindsight. One skilled in the art would not think of removing a spring from Iida's paper separator.

Claims 2, 6, 9, 17, and 18, variously dependent on claim 1, are allowable at least for their dependency on claim 1.

Independent claims 3 and 4 are allowable at least for the similar reasons as stated in the foregoing with regard to claim 1.

Claim 5, dependent on claim 4, is allowable at least for its dependency on claim 4.

The Examiner is respectfully requested to reconsider and withdraw this rejection.

(b) Claims 10-14, 19, and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida in view of Mihalik, and further in view of Shigenobu et al. (USP 4,369,719). This rejection is respectfully traversed.

Claims 10-14, 19, and 20, variously dependent on claim 1, are allowable at least for their dependency on claim 1.

The Examiner is respectfully requested to reconsider and withdraw this rejection.

(c) Claims 15 and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida in view of Mihalik, and further in view of Ogura et al. (USP 4,876,577). This rejection is respectfully traversed.

Claims 15 and 16, variously dependent on claim 1, are allowable at least for their dependency on claim 1.

The Examiner is respectfully requested to reconsider and withdraw this rejection.

Allowable Subject Matter

Applicants appreciate the Examiner's indication that claims 7 and 8 are allowable over the prior art of record.

New Claim

New claim 21 is allowable at least because none of the references of record disclose or suggest "one or more guide members, each adapted to rotate about a rotational shaft fixed to a paper-separating finger, provided at or near one or more downstream ends in one or more paper transport directions of at least one of the paper-separating fingers."

Note that in Iida, movement of the finger body 82 relies on the spring 82 and up and down movement of the shaft 38 (the downstream guide roller 37b provided at or near the downstream end of the lug 36 is supported by the lug 36 by an elongated hole 36d that allows a shaft 38 of the roller 38 to move in up and down directions), instead of the weight of the finger body *per se*.

A favorable determination by the Examiner and allowance of this claim is earnestly solicited.

Conclusion

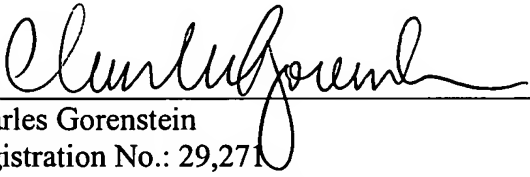
Accordingly, in view of the above amendments and remarks, reconsideration of the rejections and objections, and allowance of the pending claims are earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Maki Hatsumi (#40,417) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or to credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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